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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,919	04/14/2006	Rajinder Singh	03-004-F	1796
20306 7590 09/04/2008 MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER NOLAN, JASON MICHAEL				
ART UNIT		PAPER NUMBER		
1626				
MAIL DATE		DELIVERY MODE		
09/04/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/534,919

Applicant(s)

SINGH ET AL.

Examiner

JASON NOLAN

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 5/10/05, 10/21/05
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This Office Action is responsive to Applicants Response to Election/Restriction, filed 06/16/2008. Claims 1-20 are pending in the instant application.

Response to Restriction

Applicant's election of Group II, Claims 1-11 in the reply filed on 06/16/2008 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)). Because Group II has been elected, the remaining subject matter of non-elected Groups I & III-IX are withdrawn from further consideration.

Information Disclosure Statement

Applicants' information disclosure statements (IDS), filed on 05/10/2005 and 10/21/2005 have been considered. Please refer to Applicants' copies of the 1449 submitted herein. Any documents that are lined through have not been received from Applicant and have not been considered by Examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 2 & 11 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 24, 25, & 27 of copending Application No. 10/975,761. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter. The compounds and compositions in claims of the '761 case are essentially a subgenus of the instant formula in Claim 1 wherein Y & X = S; and A = benzimidazole.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, & 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US. 5,554,767, 09/10/1996; see IDS). Shown throughout the Patent are several compounds that anticipate the formula in Claim 11, such as Example 48 in column 27 wherein X & Y = S; R1 = H; R3 & B together form an alkenyl; A = heteroaryl; and R2 = H.

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by the CAS Abstract (attached) of Krutosikova et al. (Sbornik Prac Chemické Fakulty SVST 1971, Vol. Date 1969-1970, p. 55-8). There are several compounds that anticipate the formula in Claims 1 & 11, wherein X = O, Y = S; R1 = H; R3 & B together form an alkenyl; A = heteroaryl (furan); and R2 = H, X, NO2, CO2H, CO2Ak, OMe, Me. The abstract states, "With the object of preparing biologically active agents of low toxicity" and for this reason implies that the compounds have been developed to be used as pharmaceutical compositions.

Claim Objections

Claim 11 is objected to because of the following informalities: Claim 11 is a compound claim but includes the phrase "together with a pharmaceutical acceptable carrier, excipient, or diluent". Such a phrase is inconsistent with the meaning of a compound – which cannot be anything other than itself. Appropriate correction is required (delete phrase).

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason M. Nolan, Ph.D.** whose telephone number is **(571) 272-4356** and electronic mail is **Jason.Nolan@uspto.gov**. The examiner can normally be reached on Mon - Fri (9:00 - 5:30PM). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Joseph M^cKane** can be reached on **(571) 272-0699**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Jason M. Nolan, Ph.D./

Examiner, Art Unit 1626

/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626